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EXAMINER
COLBERT, ELLA

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/020,512	Applicant(s) CONKWRIGHT ET AL.
	Examiner Ella Colbert	Art Unit 3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Claims 1-30 are pending. Claim 1 has been amended in this communication filed 09/20/02 entered as Amendment A, paper no. 7.

2. The IDS submitted 09/20/02 has been considered and entered as paper no. 8.

3. The objection to the Specification has been overcome by Applicants' amendment to the Specification in paragraph 104 and Applicants' explanation of the acronym "STB" and is hereby withdrawn.

4. The objection to claim 19 has been overcome by Applicants' amendment to claim 19 and is hereby withdrawn.

5. The 35 U.S.C. 112, second paragraph rejection of claim 1 has been overcome by the Applicants' amendment to claim 1 and is hereby withdrawn.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims1-3, 13-19, & 23 are rejected under 35 U.S.C. 102(e) as being anticipated by (US 5,734,720) Salganicoff.

With respect to claims 1, 13, 16, 19, & 23, Salganicoff teaches, an individually targeted content delivery method comprising the steps of collecting data associated with at least one set top box (col. 3, lines 4-12); deriving at least one user model for each of the at least one set top boxes based on collected data (col. 3, lines 15-19); storing the derived at least one user model and an identifier corresponding to the set top box from which the at least one user model is derived in a storage means for later retrieval (col. 9, lines 34-55); selecting content and associated content attributes to be delivered to at least one set top box (col. 11, lines 46-67 and col. 25, lines 40-51); transmitting the selected content and content attributes to the set top box (col. 40, lines 38-57); and causing the content to be presented by the at least one set top box when a correlation exists between the content attributes and the user model associated with the set top box (col. 4, lines 38-64).

With respect to claim 13, collecting set top box interaction data associated with at least one set top box in a privacy compliant manner (col. 43, lines 17-65); deriving from said data at least one user model for each of said at least one set top boxes using a user demographic profile and a user interest profile determined using an inverse demographic matrix method (col. 37, lines 59-67, col. 38, lines 25-28, and col. 47, lines 44-54); selecting content and associated content characteristics to be delivered to at least one set top box (col. 4, lines 40-64).

With respect to claim 2, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said data is collected in a privacy compliant

manner (col. 40, lines 59-67, col. 41, lines 1-13, col. 44, lines 34-67, and col. 45, lines 1-46).

With respect to claim 3, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein data collected from said set top box includes a record of user interaction with said set top box (col. 46, lines 16-32).

With respect to claims 14 and 17, the individually targeted content delivery method of Claim 13, Salganicoff teaches, wherein said correlation is determined by said set top box (col. 3, lines 60-66 and col. 5, lines 19-28).

With respect to claims 15 and 18, the individually targeted content delivery method of Claim 13, Salganicoff teaches, wherein said correlation is determined prior to transmitting said content to said set top box, and wherein said transmitting step occurs only when said correlation is high enough to warrant said set top box presenting said content (col. 10, lines 8-23).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 4-12, 20-22, & 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salganicoff in view of (US 6,285,983 B1) Jenkins.

With respect to claim 4, Salganicoff did not teach, the individually targeted content delivery method of Claim 1, further comprising the step of transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used.

Jenkins discloses, the individually targeted content delivery method of Claim 1, further comprising the step of transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used (col. 4, lines 61-65 and col. 5, lines 9-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used and to combine Salganicoff's collecting data with Jenkins step of transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used and to modify in Salganicoff because such a modification

would allow Salganicoff's system to have sophisticated direct-to-consumer marketing initiatives in a range of industries while preserving consumer privacy.

With respect to claims 5 and 7, Salganicoff teaches, the individually targeted content delivery method of Claim 1, wherein said derived user model is based on derived user interests (col. 11, lines 43-59 and col. 14, lines 24-34). Jenkins discloses, the individually targeted content delivery method of Claim 1, wherein said derived user model is based on derived user interests (col. 1, lines 64-67 and col. 2, lines 1-2). Together Salganicoff and Jenkins teaches the claim limitations of claim 5.

With respect to claim 6, Salganicoff teaches, the individually targeted content delivery method of Claim I, wherein said derived user model is based on a derived user demographic profile (col. 4, lines 49-57 and col. 11, lines 60-67). Jenkins discloses, the individually targeted content delivery method of Claim I, wherein said derived user model is based on a derived user demographic profile (col. 1, lines 41-53). Together Salganicoff and Jenkins teaches the claim limitations of claim 6.

With respect to claim 8, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said at least one set top box user model is derived using an inverse demographic matrix method (col. 9, lines 43-55) .

With respect to claim 9, The individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said content is repeatedly presented on said selected set top boxes until it has been determined that a user has experienced said content (col. 2, lines 40-59).

With respect to claims 10, 20, & 24, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said content must be experienced before user selected content can be experienced (col. 2, lines 19-47).

With respect to claims 11, 21, & 25, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said correlation is determined by said set top box (col. 3, lines 56-67 and col. 4, lines 1-9).

With respect to claims 12, 22, & 26, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said correlation is determined prior to transmitting said content to said set top box, and wherein said transmitting step occurs only when said correlation is high enough to warrant said set top box presenting said content (col. 6, lines 14-59).

With respect to claim 27, a targeted advertising delivery system, comprising: Salganicoff teaches, a plurality of set top boxes (col. 5, lines 19-28); a content input means, which allows a content owner to submit content to the data center (col. 9, ;lines 43-55, col. 49, lines 10-23, and fig. 11 (step 1104); and

a user model selector, which allows a content owner to select user model attributes corresponding to a group to which particular content is to be delivered (col. 49, lines 46-67 and col. 50, lines 1-16).

Salganicoff did not teach, a privacy server. However, Salganicoff discloses the at least one set top box; and a data center (col. 5, lines 19-28).

Jenkins discloses, a privacy server (col. 2, lines 61-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a privacy server, communicatively connected to the at least one set top box and a data center, communicatively connected to the privacy server and to combine Salaganicoff's set top box and data center with Jenkins privacy server communicatively connected to the set top box and data center because such combination would allow their systems to communicate with individual consumer's through a secure server and send information to a set top box.

With respect to claim 28, Salganicoff teaches, a set top box (col. 5, lines 19-28). However, Salganicoff did not teach, the targeted advertising delivery system of Claim 27, in which said privacy server is responsible for removing personal information from communications received from said set top box and assigning a unique code to such data for identification purposes.

Jenkins discloses a privacy server is responsible for removing personal information from communications received from said set top box and assigning a unique code to such data for identification purposes (col. 4, lines 48-65 and col. 5, lines 14-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a privacy server is responsible for removing personal information from communications received from said set top box and assigning a unique code to such data for identification purposes and to combine Salganicoff's set top box with Jenkins a privacy server is responsible for removing personal information from communications received from said set top box and

assigning a unique code to such data for identification purposes because such a combination would allow their systems to have records that are securely stored on a secure server ensuring the privacy of individual consumers.

With respect to claim 29, Salganicoff did not teach, the targeted advertising delivery system of Claim 27, in which said data center is responsible for receiving data and associated unique identifiers from said privacy server and determining at least one user model for each set top box based on said received data.

Jenkins discloses, the targeted advertising delivery system of Claim 27, in which said data center is responsible for receiving data and associated unique identifiers from said privacy server and determining at least one user model for each set top box based on said received data (col. 4, lines 34-58 and col. 6, lines 33-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the data center responsible for receiving data and associated unique identifiers from said privacy server and determining at least one user model for each set top box based on said received data and to combine Salganicoff's set top box with Jenkins privacy server and unique identifiers because such a combination would allow their systems to have some data element that uniquely identifies and individual consumer with the system communicating through communications facilities in order to acquire and store the consumer data.

With respect to claim 30, Salganicoff and Jenkins did not teach, a computer readable program code. However, a computer readable program code is inherent

to the system to perform the steps of claim 30 involving collecting set top box events, deriving a user model in a database of user models, storing the content to be delivered to a set top box, selecting from the stored user models and the stored content of those user models and content which have a high degree of correlativity and transmitting the selected content to a set top box associated with the selected user model, and presenting the content via the set top box. A computer readable program code is well known in the art as being configured to record and to store device environment configuration information in a development system configuration managed by the operating system of the host computer to a data storage medium comprising computer readable program code that is configured to specify device information for a desired device.

Response to Arguments

10. Applicant's arguments filed 09/20/02 have been fully considered but they are not persuasive.

1. Applicants' argue: the portion of the Salganicoff patent cited by the Examiner does not teach or suggest the collection of data associated with at least one set top box, but rather the creation of "virtual channels" based on programming available from broadcasters at any given time has been considered but is not

persuasive because the data collected is from one or more of the channels. Prior to the receipt of this collected data it is collected from the customer's set top multimedia terminal (set top box). The Examiner interprets this to read on Applicants' claim limitation "collecting data associated with at least one set top box."

2. Applicants' argue: the portion of the Salganicoff patent cited by the Examiner does not teach the derivation of a user model based on data collected from a set top box, but rather teaches the creation of a virtual channel which contains programming most desirable to the customer has been considered but is not persuasive because claim 1, element two recites "deriving at least one user model for each of said at least one set top boxes." This claim limitation is not clear because something is missing. Either the claim limitation should recite "deriving at least one user model for each of the set top boxes" or "deriving at least one user model for each of said at least one set top box." Clarification of the wording of the claim limitation is respectfully requested. The Examiner interprets Applicants' to mean the user model is derived from many set top boxes and considers col. 3, lines 15-19 to read on this limitation.

3. Applicants' argue: the portion of the Salganicoff patent cited by the Examiner does not teach storing derived user models and set top box identifiers,

but rather teaches characterizing content according to predetermined characteristics has been considered but is not persuasive because this claim limitation recites "storing said derived at least one user model (one user model) and an identifier (one identifier) corresponding to the set top box from which said at least one user model is derived in a storage means for later retrieval." The claim limitation is understood by Examiner as "one user model" but the "user model" could be more than one and the "identifier is just one "identifier" and not more than one "identifier". Therefore, it is interpreted by the Examiner that Salganicoff teaches, "storing at said derived at least one user model ..." in col. 9, lines 34-55.

4. Applicants' argue: the sections of the Salganicoff patent cited by the Examiner clearly do not disclose all of the elements of Applicants' invention as claimed in claim 1 has been considered but is not persuasive based on the Applicants' fail to appreciate the breadth of the claims. In particular "deriving at least one user model for each of said at least one set top boxes ...". The preamble references "at least one set top box" not "at least one set top boxes." The claim language appears to be inconsistent with the recitation in the preamble and in the remaining claim limitations of claims 1, 3, 8, 11, 12, 14, 15, 17, 18, 20-22, and 24-30.

5. Applicants' argue: the cited portion of the Salganicoff patent does not teach the user of an inverse demographic matrix to derive user models has been considered but is not persuasive based on Salganicoff does teach, the use of an inverse demographic matrix to derive user models has been considered but is not persuasive based on Salganicoff does teach, "creating a matrix based on demographic or psychographic data (a chart graphically represented by personality traits of an individual)" in col. 37, lines 59-67, col. 38, lines 25-28 (an inverse process) and col. 47, lines 44-54.

6. Applicants' argue: no motivation to combine Jenkins and Salganicoff patents with any other prior art suggest Applicants' claimed invention has been considered but is not persuasive based on the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Salganicoff teaches, collecting data associated with on set top box, deriving from the data a user model for each of the set top boxes using a demographic matrix, selecting the content and associated content characteristics delivered to at least one set top box, and the data collected is

privacy compliant, the correlation is determined by the set top box and Jenkins discloses transmitting data to a privacy server which removes all personally identifiable information from the data before allowing the data to be used, derived user model is based on derived user interests, the derived user model is based on a derived user demographic profile, a privacy server responsible for removing personal information from communications received from the set top box and assigning a unique code to such data for identification purposes, the data center is responsible for receiving data and associated unique identifiers from the privacy server and determining at least one user model for the set top box based on the received data, and a computer readable program. Together it is interpreted by the Examiner that the references teach Applicants' invention. The Examiner's supported statement that such a combination would have been obvious comes from the Jenkins reference in col. 4, lines 7-10. The Applicants' are respectfully requested to read the references prior to making unsubstantiated allegations that the motivation is not supported by the references.

7. Applicants' argue: the Examiner's combination of Salganicoff and Jenkins patents is believed to be motivated by hindsight, rather than by a teaching or suggestion within the prior art has been considered but is not persuasive based on the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge

which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In conclusion, with respect to the Applicants' arguments concerning: the Salganicoff and Jenkins patents do not teach or suggest all of the claim limitations of claims 1-30 has been carefully considered but is not persuasive because in this rejection of claim 1 and others, for example under Sections 102(e) and 103(a) of Title 35 of the United States Code, the Examiner carefully dew up a correspondence between Applicants' claimed elements and one or more referenced passages in the Salganicoff and Jenkins references, what is well known in the art, and what is known to one having ordinary skill in the art (the skilled artisan). The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION
During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Non-Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

E. Colbert
November 26, 2002

HANI M. KAZIMI
PRIMARY EXAMINER